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Paul H. Robb

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PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL H. ROBB

Appeal 2009-004312
Application 09/877,926
Technology Center 3600

Decided: September 25, 2009

Before, MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-59. We have jurisdiction under 35 U.S.C. § 6(b). (2002) An Oral Hearing was held on September 9, 2009.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant claims a system and method for providing a collaboration tool where advisors, clients and/or other participants may access client data by interaction in common forum, such that consistent and accurate collaboration of resources and information may be achieved.

(Spec. 1:12-15).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer implemented for enabling a financial services client and one or more financial service provider participants to collaborate as a team comprising the steps of:

enabling a collaboration team comprising one or more participants to be defined; providing a common electronic forum containing client data wherein client data is accessible by one or more financial service provider participants wherein each participant has predefined authorizations; and

enabling the financial services client to interact with one or more financial service provider participants through the common electronic forum wherein the common electronic forum further enables interaction among the one or more participants through the common forum where client data is accessible within the scope of access authorized to each participant.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Carter	5,787,175	Jul. 28, 1998
Zucknovich	5,940,843	Aug. 17, 1999

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Day	US 6,243,733 B1	Jun. 5, 2001
Moran	US 6,430,542 B1	Aug. 6, 2002

The following rejections are before us for review.

The Examiner rejected claims 1-59 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

The Examiner rejected claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 under 35 U.S.C. § 103(a) as being unpatentable over Zucknovich.

The Examiner rejected claims 6, 20-21, 33, and 47-48 under 35 U.S.C. § 103(a) as being unpatentable over Zucknovich in view of Moran.

The Examiner rejected claims 55-56 stand under 35 U.S.C. § 103(a) as being unpatentable over Zucknovich in view of Carter.

ISSUES

Has Appellant shown that the Examiner erred in rejecting claims 1-59 under 35 U.S.C. § 112, on the grounds that those skilled in the art would understand that the words, "collaborate" "enabling" "to interact" "forum," "events" and "actions," "client" and "participants" "library of resources" and "system" are definite when the claims are read in light of the specification?

Has Appellant shown that the Examiner erred in rejecting claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 on appeal as being unpatentable under 35 U.S.C. § 103(a) over Zucknovich on the grounds that a person with ordinary skill in the

art would understand that the disclosure in Zucknovich of a contributor posting a report on the repository server and an investor downloading same from the server constitutes interaction thereby meeting the claim language; and whether the claimed client data can distinguish patentability based on the content of the involved data?

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

Novelty/Obviousness Nonfunctional Descriptive Material

When “non-functional descriptive material” is recorded or stored in a memory or other medium (i.e., substrate) it is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship

to the substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983).

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability.)

The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Appellant's Specification does not specifically define the term "forum", nor does it utilize the term contrary to its customary meaning.
2. The Specification only discusses forums in the context of "the advisors (or authorized participants) 102, 104, and 106 may communicate with client 110 as well as each other through password protected forums to retrieve various documents and information from fellow advisors (or participants) and/or from client 110 through collaboration tool 120 of the present invention." (Spec. 13:5-8).

3. The ordinary and customary definition of the term “forum” as defined *inter alia* by Merriam Webster’s Collegiate Dictionary (10th ed.) is: a medium (as a newspaper) of open discussion or expression of ideas.

4. Zucknovich discloses that a contributor via contributor workstations 14, 16, 18, 19 are used by brokerage and investment banking firms to submit reports to the repository server 2. (col. 5, ll. 62-64).

5. The reports in Zucknovich are investment research reports. (col. 5, l. 44).

6. Zucknovich discloses

[t]he repository server 2 provides investors with lists of reports received from the contributor workstations 14, 16, 18, 19 and allows investors to request lists of reports that fit certain criteria. The investor can select reports from these lists to down-load, view and/or print. Generally, lists of reports can be generated by the web server 4. (col.7, ll. 26-31).

7. Zucknovich discloses

[t]he contributor of a report can be notified that a particular investor has accessed that report. The repository server 2 maintains for each report a list of those who accessed that report. The repository server 2 can transmit that list to the report's contributor on a regular basis and/or when requested by the contributor. (col.7, ll. 32-38).

8. Zucknovich discloses

[w]hen an investor makes a query for a list of reports, the investor's Internet browser sends an HTTP (hypertext transfer protocol) request that represents what the user wants to the web server 4. If the request does not have a verification signature attached to it, the web

server 4 sends a command back to the Internet browser, causing it to prompt the user for an ID and password. The Internet browser will then return this information to the web server 4, which will verify that the user is entitled to access the reports stored at the repository server 2. If the user is verified, the Internet browser will be given a verification signature. If not, the user will be prompted again for his ID and password. Once access is verified, the web server 4 will start the CGI program named in the original HTTP request, along with any run-time parameters that are specified in the request. The CGI program first verifies that the user making the request (whose ID is passed to the CGI program by the web server 4 through, for example, an environment variable) is the only one using that ID at that moment. (col. 8, ll. 42-61).

9. The Specification describes using technology to overcome information dissemination problems in that

...technologies may be utilized for coordinating administrative operations, disseminating information or documents for review and retention, individual access to investment information, reference and research libraries and providing information inputs for ongoing financial, legal, investment and other support and functions. (Spec. 3: 4-7).

10. The ordinary and customary definition of the term “interaction” as defined *inter alia* by Merriam Webster’s Collegiate Dictionary (10th ed.) is: mutual action or influence.

ANALYSIS

1. We will not sustain the rejection of claims 1-59 under 35 U.S.C. § 112, second paragraph.

2. We have carefully considered the arguments addressing the rejections made under 35 U.S.C. § 103(a) and find, on balance and in light of the breadth of the claims, the facts support the Examiner's position and thus the Appellant's arguments are not persuasive as to error in the rejections. We thus affirm the rejections of claims 1-59 made under 35 U.S.C. § 103(a).

1. 35 U.S.C. § 112, Second Paragraph Rejection

The Examiner maintains that claims 1-59 are indefinite because the claims use the follow words which the Examiner considers to be confusing: "collaborate" "enabling" "to interact" "forum," "events" and "actions," "client" and "participants" "library of resources" and "system." (Ans. 5). We disagree with the Examiner. Each of the terms when read in light of the Specification can be reasonably understood to render a valid interpretation of the involved claim language.

For example, the Examiner maintains that it is unclear whether the system recited in claims 28-54 is either a method or an apparatus. (Answer 6). However, our review of the Specification shows that the referenced system 100 is an apparatus comprised of a communication device 103 and a connected network 108, and thus its use in the claims as an apparatus is definite. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d

1081, 1088 (Fed. Cir. 1986) (citations omitted). Accordingly, we are persuaded of error in the rejection.

2. The 35 U.S.C. § 103(a) Rejections

Appellant's arguments against each of the 35 U.S.C. § 103(a) rejections are based on perceived deficiencies of Zucknovich. Inasmuch as Appellant raises the same issues with respect to each of these rejections, we discuss the rejections together, addressing each of Appellant's arguments in turn.

Initially, we note that the Appellant argues claim 1 as representative of all independent claims. Correspondingly, representative claim 1 will decide the appeal of the claims 2-5, 7-19, 22-32, 34-46, 49-54, and 57-58.

Appellant argues that "[t]here is no communication or 'interaction' between the investors and contributors, whereas claim 1 recites "enabling the financial services client to interact with one or more financial service provider participants through the common electronic forum." (Appeal Br. 12).

We disagree with Appellant. Appellant's Specification does not specifically define the term "forum", nor does it utilize the term contrary to its customary meaning (FF 1, 2). The ordinary and customary definition of the term "forum" is a medium (as a newspaper) of open discussion or expression of ideas. (FF 3). We find that in Zucknovich contributors via contributor workstations are used by brokerage and investment banking firms to submit or post reports to the repository server 2. (FF 4). The reports are investment research reports. (FF 5). In turn, [t]he repository server 2 provides investors with lists of reports received from the contributor workstations and the investor can select reports from these lists to

down-load, view and/or print (FF 6). The ordinary and customary definition of the term “interaction” is defined *inter alia* as mutual action or influence (FF 10). The repository server 2 thus serves as a common or mutual resource medium for investors, influencing them by the analysis of the reports which are downloaded and read. We thus find that the process of a contributor posting a report on the repository server and an investor subsequently downloading same from the repository server constitutes interaction through a common forum thereby meeting the claim language.

Appellant next argues that “because the content of the reports describe neither the research contributors nor the recipients of the report, the reports cannot be reasonably considered ‘client data’... That is, the content of the research pertains to third parties, and thus is clearly not ‘client data,’ as alleged by the Examiner.” (Appeal Br. 11). We disagree with Appellant.

Appellant is effectively arguing a patentable distinction based on the content of the involved data. Patentable weight need not be given to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. *See In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). *See also Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (Federal Circuit Appeal No. 2006-1103; affirmed without written opinion Aug. 17, 2006). Claim 1 only requires that client data be accessible within the scope of access authorized to each participant and falls short of tying function of the content to the scope of the access authorized to each participant.

Appellant also argues the Examiner “failed to provide evidence” for a dependent claim which recites “wherein the common forum provides modification information associated with client data wherein modification information comprises one or more actions associated with one or more participants.” (Appeal Br. 12). However, as found *supra*, Zucknovich discloses modification information in the form of a list of those who accessed a given report (FF 7), which accessing is read as an action associated with the investor/participant. Since the Examiner did make reference to the use of such a “client history database” as evidence of this function (Ans. 6), we do not find error in the Examiner’s rejection with respect to this contention.

Appellant finally argues that Zucknovich is non-analogous art because

Zucknovich's field of endeavor is the electronic distribution of research reports to authorized recipients, and the particular problem addressed therein is allowing a research provider to filter or restrict opinions and reports, or somehow indicate to clients and investors that a company is under review. (Appeal Br. 12).

We disagree with Appellant. The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *See In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *See Oetiker at 1447*. (“[I]t is necessary to consider ‘the reality of the circumstances,’ in other words, common sense-in deciding in which fields a person

of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” *Id.* (quoting *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979)). *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006).

In this case, we characterize the general problem facing the Appellant as optimizing technology to disseminate information or documents for review and retention, individual access to investment information, reference and research libraries and providing information inputs for ongoing financial, legal, investment and other support and functions. (FF 9). This problem is congruent with that addressed by Zucknovich in the selective dissemination of investment reports to investors by contributors who effectively create a library of data reports on the repository server for access by investors (FF 4-6, 8). Thus, we find that Zucknovich is reasonably pertinent to the problem the Appellant was trying to solve, because it is concerned with the general problem of disseminating investment information, and we thus conclude it is analogous art.

Appellant does not advance additional arguments to the other, separate rejections made under 35 U.S.C. § 103(a). Accordingly, we will not sustain the remaining rejections of the claims for the reasons set forth above.

CONCLUSIONS OF LAW

We conclude the Appellant has shown that the Examiner erred in rejecting claims 1-59 under 35 U.S.C. § 112, second paragraph.

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 under 35 U.S.C.

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§ 103(a) as allegedly being unpatentable over Zucknovich.

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 6, 20-21, 33, and 47-48 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of Moran.

We conclude the Appellant has not shown that the Examiner erred in rejecting claims 55-56 stand under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich in view of Carter.

DECISION

The decision of the Examiner to reject claims 1-59 is AFFIRMED.

AFFIRMED.

JRG

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102